

Docket No.: 63288-253

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

John OVERMAN, et al.

Serial No.: 09/694,653

Filed: October 23, 2000

For: FLATS MAIL AUTOTRAYER SYSTEM

: Customer Number: 20277

: Confirmation Number: 3830

: Group Art Unit: 3652

: Examiner: Krizek, Janice Lee

**RESPONSE TO RESTRICTION REQUIREMENT**

Mail Stop Fee Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Noting the Office Action of July 15, 2003 wherein restriction has been required, Applicants hereby provisionally elect Group II (claims 15-50) for prosecution in the above-identified application, with traverse.

The Examiner alleges that groups I and II correspond to subcombinations usable together (MPEP §806.05(d)). However, claim 1 recites “means for combining multiple small stacks of mailpieces into a single large stack of mailpieces while maintaining a sequence order; and means for transferring said large stack to a tray.” Claim 15 recites, *inter alia*, “said stack accumulator combining said small stacks of mailpieces into said large stack in a desired sequence, and transferring said large stack to said tray ....” Based on the recited claim language, the Examiner should have made a restriction requirement under combination/subcombination (See MPEP §806.05(c)), and not subcombination usable together. Subcombinations usable together would

be proper if the claim groups recited entirely different elements which are usable together. However, this does not apply, at least based on the grouping of the claims of this application.

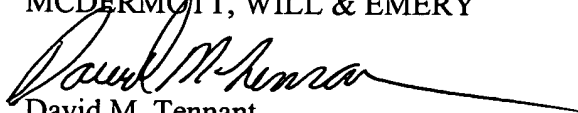
In order to establish that combination/subcombination inventions are distinct, two-way distinctness *must* be demonstrated. (See MPEP §806.05(c)). However, the Examiner has only alleged that invention II (claims 15-50) has separate utility such as use in conveying a stream of mailpieces. In other words, the Examiner has based restriction on one-way distinctness, which is improper for combination/subcombination theory.

In conclusion, the Examiner has failed to establish a *prima facie* case of restriction between Groups I and II, although other grounds may be possible. Applicants submit that the election of one group or the other is not needed and that the restriction requirement should be entirely withdrawn. Applicants therefore request prompt reconsideration and examination of all of the originally pending claims in this one case.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

  
David M. Tennant  
Registration No. 48,362

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 DT:MWE  
Facsimile: (202) 756-8087  
**Date: November 17, 2003**